

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES A. PELL
and STEPHEN A. WAINWRIGHT

Appeal No. 1999-0069
Application 08/388,741¹

ON BRIEF

Before CALVERT, ABRAMS, and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner

¹Application for patent filed February 15, 1995.
According to appellants, this application is a continuation-in-part of Application 08/016,167, filed February 10, 1993, now abandoned.

Appeal No. 1999-0069
Application No. 08/388,741

finally rejecting claims 1-18, which constitute all of the claims of record in the application.

The appellants' invention is directed to a swimming creature simulator. The claims before us on appeal have been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

King	1,661,758	Mar. 6, 1928
Eastep	3,165,086	Jan. 12, 1965
Wood	3,874,320	Apr. 1, 1975
Kindred	4,172,427	Oct. 30, 1979
Glover (UK)	582,928	Dec. 2, 1946

THE REJECTIONS

Claims 1-8 and 12-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Glover in view of Eastep and Wood or Kindred.

Claims 9-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Glover in view of Eastep and Wood or Kindred, taken further in view of King.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the

Appeal No. 1999-0069
Application No. 08/388,741

appellants regarding the rejections, we make reference to the Examiner's Answer (Paper No. 14) and the Appellants' Brief (Paper No. 13).

OPINION

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

It is our view that a *prima facie* case of obviousness has not been established with regard to the subject matter recited in any of the claims, and we therefore will not sustain either of the rejections. Our reasoning follows.

Basic to the appellants' invention is that the undulating movement provided to the swimming creature to which the invention is directed causes the creature to propel itself through the water in a manner that simulates the movement of a live fish. As manifested in independent claim 1, the invention comprises a unitary elongate body of elastomeric material having a center of mass,² a rearward portion rearward of the center of mass and a forward portion forward of the center of mass, with the rearward portion being tapered rearwardly so that it has a greater cross-sectional thickness toward the center of mass, and means for imparting oscillating rotational motion at a point forward of the center of mass about an axis perpendicular to the frontal plane of the body and lying in the median plane thereof. With regard to the

²In view of the common definition, and considered in the context of the appellants' disclosure, we interpret "mass" to mean the weight of the material of which the body is formed. See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, page 715.

subject matter recited in claim 1, it is the examiner's position that Glover teaches all except for being "silent as to the shape of the rubber body," a feature which, in the examiner's view, "would have been obvious to the ordinary skilled person in the art, since the Glover device is to simulate a fish," as would the elasticity of the material from which the body is made, "through routine experimentations" (Answer, page 4). Notwithstanding this line of reasoning, the examiner combines with Glover the Eastep reference for its disclosure of a fish-shaped rubber body and, alternatively, with Wood or Kindred for their teachings of utilizing unitary body structures in a propelling device.

Glover is directed to a submersible toy that is in the shape of a fish. The toy is illustrated and described as being a "flat body" (Figure 2; page 2, lines 63-64)), although it is stated in the Glover specification that it can also be a "hollow flexible body of rubber or other waterproof material" (page 2, lines 65-67). Even if one considers, *arguendo*, that the body of the Glover device is made of elastomeric material, with regard to the requirements of claim 1, it is our view that this reference has several deficiencies. First, there is

no teaching of making the body of the device "approximately as dense as water," as required by claim 1, and no reason to do so inasmuch as control of the device is entirely dependent upon the actions of the user (page 1, line 19 *et seq.*).

Second, there is no mention of the center of mass nor, it follows, does the reference teach locating the elements of the device in terms of their relationship to the center of mass, as is set forth in the claim. From our perspective, it thus is speculative to conclude that these relationships exist in the reference. Third, the device shown in the Glover drawings is essentially flat and therefore does not have a rearward tail portion that is "tapered rearwardly in a frontal plane," and the specification of the reference fails to describe such a configuration as an alternative thereto. Finally, while the Glover device is equipped with means attached near the front which is capable of imparting oscillating motion (page 2, line 55), it does not propel itself through the water, but is caused to move through the water "manipulated by hand control to cause it to perform swimming, diving, floating and other motions . . . in water" (page 1, lines 35-37 and 77-80). Therefore, it is clear that the oscillation does not produce

"rearward traveling undulating movements . . . which propel said elastomeric body through the water," as is recited in claim 1.

All three of the secondary references are directed to devices that utilize the oscillating motion of a member for propulsion. In the Eastep arrangement, an oscillating propeller is comprised of a plurality of longitudinally connected rigid elements that are biased at their hinge points so that they move back and forth as is shown in Figure 6. Wood and Kindred disclose flexible propelling members comprising a single elongated flexible element. However, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Because the Glover device is not intended to propel itself through the water, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the toy disclosed therein by providing it with a propelling mechanism, other than the hindsight accorded one who first viewed the appellants' disclosure. This, of course,

Appeal No. 1999-0069
Application No. 08/388,741

is not a proper basis upon which to base a conclusion of obviousness. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Furthermore, even if the required suggestion were present, there clearly is no teaching in any of the references of making the Glover toy "approximately as dense as water," and there is no reason why this would even be desirable. Further in this regard, the references are not concerned with the center of mass of the device and do not explicitly locate it or teach the required relationships between the center of mass and the various elements, nor does there appear to be any reason to do so.

In view of the preceding, the rejection of independent claim 1 and dependent claims 2-8, 12 and 13 cannot be sustained.

Independent claim 14 contains all of the limitations missing from the Glover reference, except for the density requirement. This claim also stands rejected on the basis of Glover in view of Eastep and either Wood or Kindred. For the same reasons set forth above with regard to independent claim

Appeal No. 1999-0069
Application No. 08/388,741

1, we find ourselves unable to sustain the rejection of claim 14 and claims 15-18, which depend therefrom.

Inasmuch as the teachings of King do not alleviate the problem discussed above with regard to Glover, Eastep, Wood and Kindred, we also will not sustain the rejection of claims 9-12, which depend from claim 1.

Appeal No. 1999-0069
Application No. 08/388,741

SUMMARY

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

	Ian A. Calvert)	
	Administrative Patent Judge)	
)	
)	
)	
	Neal E. Abrams)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
	John P. McQuade)	
	Administrative Patent Judge)	

tdl

Appeal No. 1999-0069
Application No. 08/388,741

BELL, SELTZER, PARK & GIBSON, P.C.
P.O. Drawer 34009
Charlotte, NC 28234